

REMARKS

Claims 1-22 are pending. Claims 1-22 are rejected by this Office Action. Applicant is amending claims 1, 10, 19, and 20. Applicant requests reconsideration of claims 1-22 for the reasons as will be discussed.

Substance of Interview on June 29, 2009

Applicant and Examiner Coughlan discussed the 112 rejections of claims 1-22 and the 101 rejections of claims 19-21. Examiner Coughlan indicated that the proposed amendments would overcome the 101 and 112 rejections. Applicant and Examiner Coughlan also discussed the "show me" function, as discussed in Chiang, in regards to the 103 rejections. However, no agreement was reached on the 103 rejections.

Claim Rejections – 35 U.S.C. §112

Claims 1-22 are rejected under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the written description requirement.

Regarding claim 1, Applicant is amending the claim to include the feature of "firing the at least one profile to identify mistakes and correct answers provided by the student." The amendment is supported by the specification as originally filed, e.g., page 18, lines 17-19. Applicant is similarly amending independent claim 10 to include the feature of "firing the at least one profile to identify mistakes and correct answers provided by the student." Applicant is also amending independent claim 19 to include the feature of "firing the at least one profile to identify mistakes and correct answers provided by the student." The Office Action alleges that (Page 3.):

The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The independent claims recite, 'firing the at least one profile when an incorrect answer is provided by the student.' This is not supported by the specification. Page 18 of the specification recites 'Some of the profiles fire as they identify the mistakes and correct answers the students has given.' This is not equivalent to the claim language. The claim language states a firing of a profile when an incorrect answer is given. The specification states that 'some' of the profiles fire. When these profiles do 'fire' it is based on when both mistakes and correct answers are given by the student. The specification does not support the claims.

Applicant believes that claims 1, 10, and 19 are consistent with the teaching that “Some of the profiles fire as they identify the mistakes and correct answers the students has given.” Claims 2-9, 11-18, and 20-22 ultimately depend from claims 1, 10, and 19. Applicant thus requests reconsideration of claims 1-22.

Claim Rejections – 35 U.S.C. §101

Claims 19-21 rejected under 35 U.S.C. 101 because they describe software which is non-statutory under 35 U.S.C. §101.

Applicant is amending claim 19 to directed to “A computer-readable medium encoded with computer-executable instructions that when executed perform.” The amendment is supported by the patent application as originally filed, e.g., Figure 1 and page 3, lines 1-23. The Office Action alleges that (Pages 3-4.):

Claims 19-21 rejected under 35 U.S.C. 101 because they describe software which is non-statutory under 35 U.S.C. §101. ‘A computer readable medium for creating a tutorial presentation and having computer executable instructions to perform steps’ and ‘The computer readable medium of claim 19, containing further computer executable instructions for’ are describing software only.

Applicant believes that claims 19 and 20 are in concert with MPEP §2601.01(I) because the claims are directed to a computer-readable medium encoded with a computer program.¹ Also, Applicant believes that the rejection of claim 21 under 35 U.S.C. 101 is improper because the claim is direct to a method and is not directed to a computer-readable medium as alleged. Applicant requests reconsideration of claims 19-21.

¹ MPEP §2601.01(I) recites “Similarly, computer programs claimed as computer listings *per se*, i.e., the descriptions or expressions of the programs, are not physical “things.” They are neither computer components nor statutory processes, as they are not “acts” being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program’s functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program’s functionality to be realized, and is thus statutory. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035. Accordingly, it is important to distinguish claims that define descriptive material *per se* from claims that define statutory inventions.” (Emphasis added.)

Claim Rejections – 35 U.S.C. §103

Claims 1-3, 5, 7, 10-12, 14, 16, and 19-22 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over the combination of anticipated by U.S. Patent No. 5,535,422 (Chiang) and International Patent Publication WO 98/44443 (RationalInvestors).

Regarding claim 1, Chiang and RationalInvestors, either individually or in combination, fails to suggest the features of “**firing the at least one profile to identify mistakes and correct answers provided by the student**” and “**triggering a topic in a concept tree when the at least one profile fires**, wherein the concept tree contains a plurality of concepts associated with the current simulation task and, wherein the tutorial presentation provides a cognitive educational experience.” (Emphasis added.) The Office Action alleges (Pages 6-7. Emphasis added.):

Chiang anticipates displaying details of the computer-implemented method and displaying the tutorial presentation as the tutorial presentation executes (Chiang, C9:24 through C10:41; ‘Displaying details’ of applicant is accomplished by the ‘tutorial window’ and the ‘product window’ of Chiang.) and further comprises: firing the at least one profile when an incorrect answer is provided by the student (Chiang, C1:44-61; Firing at least one profile when a mistake is made of applicant is disclosed as ‘In addition, online tutorials typically include the capability of monitoring student actions and advising when a mistake has been made. Moreover, if the user requires assistance, a preprogrammed demonstration can be requested to perform the correct action(s) to be taken’ of Chiang.); and triggering a topic in a concept tree when the at least one profile fires, wherein the concept tree contains a plurality of concepts associated with the current simulation task (Chiang, C3:21-45, C5:36- 57; Chiang discloses ‘lesson panels’ which are linked ‘hierarchically to step panels.’ This hierarchical structure of Chiang is equivalent to a ‘tree’ structure of applicant. Chiang also discloses that the concept panels are linked to the lesson panels in a ‘parallel relationship.’ Thus the concept panels of Chiang are linked in a hierarchical structure which is equivalent to a ‘concept tree’ of applicant. Therefore ‘triggering a topic in a concept tree’ of applicant is illustrated by ‘demonstration assistance or ‘show me’ of Chiang.’), wherein the tutorial presentation provides a cognitive educational experience. (Chiang, abstract; ‘Cognitive educational experience’ of applicant is equivalent to ‘interactive online tutorial system’ of Chiang.)

While the Office Action alleges that “Firing at least one profile when a mistake is made” is disclosed by Chiang because Chiang discusses online tutorials monitoring student actions and advising when a mistake has been made, Chiang fails to suggest any thing that relates a mistake or advise to a “topic in a concept tree.” (Column 1, lines 53-57.) The Office Action further alleges that “triggering a topic in a concept tree” is illustrated by demonstration assistance (“show me”), which appears to be the alleged profile firing, as discussed by Chiang. However,

Chiang fails to suggest firing a profile “to identify mistakes and correct answers provided by the student.” Chiang merely discusses a different mechanism for executing a tutorial other than inputting mistakes and correct answers provided by a user. Rather than the tutorial system determining whether the user’s action is correct (either the answer is correct or is a mistake), the tutorial system supports a separate show-me function in which the tutorial performs one or more input actions to drive the product.² (Column 8, lines 23-40.) In other words, with the show-me function the user does not even provide an answer (correct or a mistake) to the tutorial system. Consequently, the tutorial system of Chiang shows users what to do in a lesson by the tutorial system by actually driving the product to perform the input actions in a lesson. (Column 18, lines 52-59.) Moreover, RationalInvestors fails to remedy the deficiencies of Chiang.

Independent claim 10 includes the similar features of “firing the at least one profile to identify mistakes and correct answers provided by the student” and “triggering a topic in a concept tree when the at least one profile fires, wherein the concept tree contains a plurality of concepts associated with the current simulation task and, wherein the tutorial presentation provides a cognitive educational experience.” Also, independent claim 19 includes the features of “firing the at least one profile to identify mistakes and correct answers provided by the student” and “triggering a topic in a concept tree when the at least one profile fires, wherein the concept tree contains a plurality of concepts associated with the current simulation task and, wherein the tutorial presentation provides a cognitive educational experience.” Claims 2-3, 5, 7, 11-12, 14, 16, and 20-22 ultimately depend from claims 1, 10, and 19. Applicant requests reconsideration of claims 1-3, 5, 7, 10-12, 14, 16, and 19-22.

² For example, the specification recites “The tutorial monitors what users are doing in the product by intercepting messages to the product in the OS/2.TM. Presentation Manager™ message queue before they get to the product. It then compares the user action with the expected action to see whether the user’s action is correct. A show-me function is also provided wherein the user may request the tutorial to perform one or more input actions to drive the product. These action commands are passed to the product in the form of messages. The lesson control file is utilized by the tutorial for the monitoring and show-me functions. This control file contains commands that correspond to actions specified by the tutorial’s lessons, which users are to perform. For the show-me function, the tutorial interprets the commands and reformats them as OS/2™ messages to drive the product to perform the lessons’ actions. For the monitoring function, the tutorial compares user input with the commands in the lesson control file, to determine whether user input is correct.” (Col. 8, lines 23-40. Emphasis added.)

Claims 4, 6, 8, 9, 13, 15, 17, and 18 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over the combination of Chiang and RationalInvestors in view of U.S. Patent No. 5,372,507 (Goleh).

Claims 4, 6, 8, 9, 13, 15, 17, and 18 ultimately depend from independent claims 1 and 10. Moreover, the deficiencies of Chiang an RationalInvestors are not remedied by Goleh, and thus claims 4, 6, 8, 9, 13, 15, 17, and 18 are patentable for at least the above reasons. Applicant requests reconsideration of claims 4, 6, 8, 9, 13, 15, 17, and 18.

All objections and rejections have been addressed. Hence, it is respectfully submitted that the present application is in condition for allowance, and a notice to that effect is earnestly solicited.

Respectfully submitted,

Date: July 17, 2009

/Kenneth F. Smolik/

Kenneth F. Smolik
Registration No. 44,344
BANNER & WITCOFF, LTD.
10 S. Wacker Drive, Suite 3000
Chicago, IL 60606-7407
Telephone: 312-463-5000
Facsimile: 312-463-5001